

REMARKS

Claims 1-13 are all the claims pending in the application. Claim 1-6 are hereby canceled by this Amendment without prejudice or disclaimer.

Claim Objections

The Examiner objected to claim 7 for an informality. Applicants request that the Examiner withdraw this objection in view of the self-explanatory claim amendment to claim 7.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1-13 under § 112, second paragraph, as being indefinite. In particular, the Examiner contends that the recitation “a first and a second end in a direction of a motor central axis,” renders the claims indefinite. Applicants submit that the present claim amendment to claim 7 overcomes this rejection. The rejection is moot with regard to claim 1 which is canceled by this Amendment.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 1-6 under § 103(a) as being unpatentable over Suzuki et al. (2002/0043880) in view of Scott (US 2002/0063492).

Applicants submit that this rejection is moot in view of the cancellation of claims 1-6 by this Amendment.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 7, 10 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki in view of Jenkin (US 3,639,791). Applicants traverse this rejection as follows.

The Examiner alleges that Suzuki discloses most of the features of the rejected claims, but concedes that Suzuki fails to disclose a penetrating aperture through a first end of said

exterior casing, or a filter disposed so as to cover said penetrating aperture from said second end of said exterior casing. To compensate for this deficiency, the Examiner applies Jenkin alleging it teaches a penetrating aperture disposed through a first end of said exterior casing so as to communicate between an interior portion of said bushing and an exterior portion of said exterior casing, and a filter disposed so as to cover said penetrating aperture from said second end of said exterior casing.

First, Applicants incorporate the arguments submitted in the September 7, 2006, Amendment in which Applicants submitted that Jenkins was non-analogous art. Second, Applicants submit that the Examiner has failed to establish *prima facie* obviousness, because the purported motivation to combine is not supported by any of the applied references. Thus, the Examiner's rejection appears to be the result of a prohibited hindsight analysis.

As a motivation to combine, the Examiner alleges that one having ordinary skill in the art at the time of the invention would modify the teachings of Suzuki with a penetrating aperture and filter, as taught by Jenkin, for the purpose of circulating a fluid, providing a communicating fluid path with a filter, and filtering contaminants from the fluid to provide for a smooth operation and extended life.

Applicants submit that this is a motivation proffered by the Examiner based on a hindsight reconstruction as to why one would combine Jenkin with Suzuki. In particular, Applicants submit that the Examiner has failed to interpret the teachings of Jenkins as a whole, instead, choosing to rely on individual elements without any reference to what Jenkin teaches about the purpose of the elements.

In contrast to the Examiner's motivation to combine, Applicants respectfully submit that Jenkin teaches that opening 36 communicates with an input conduit 41 through a filter 38, only because the conduit 41 is connected to a source of air under pressure. (col.2, lines 70-75) The reason for including this source of air is to provide bearing support. (col. 1, lines 9-13). However, because the actuator of Suzuki does not constitute a hydrostatic bearing and otherwise fails to contain the other features taught by Jenkin as essential to the function of the hydro-static bearing, Applicants submit that one of ordinary skill in the art would not be motivated to combine Jenkin with Suzuki as suggested by the Examiner. There is simply no objective basis to provide an opening 36 so as to provide a source of air under pressure. Moreover, Jenkin provides no other reason for introducing an opening 36, except as an air supply for a hydrostatic bearing.

Thus, because the Examiner has failed to establish *prima facie* obviousness, Applicants submit that claims 7, 10 and 11 are allowable over the applied combination of Jenkin and Suzuki.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 8 and 9 stand rejected under § 103(a) as being unpatentable over Suzuki in view of Jenkin and in further view of Scott (US 2002/0063492)

Applicants submit that because, as discussed above, the Examiner has failed to establish *prima facie* obviousness to combine Suzuki with Jenkin, and Scott fails to compensate for this deficiency, claims 8 and 9 are allowable for the same reasons set forth above.

Claim Rejections - 35 U.S.C. § 103(a)

The Examiner rejected claims 12 and 13 under § 103(a) as being unpatentable over Suzuki in view of Jenkin (US 3,639,791).

However, because the Examiner provides the same motivation to combine Jenkin with Suzuki as set forth above with regard to claim 7, Applicants submit that claims 12 and 13 are allowable, at least for the same reasons set forth above with regard to claim 7.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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